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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/798,842	03/11/2004	Phillip Robert Kavanagh	142.010US01	5028
34206	7590	06/02/2005	EXAMINER	
FOGG AND ASSOCIATES, LLC P.O. BOX 581339 MINNEAPOLIS, MN 55458-1339			COLLINS, TIMOTHY D	
			ART UNIT	PAPER NUMBER
			3643	

DATE MAILED: 06/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/798,842

Applicant(s)

KAVANAGH, PHILLIP ROBERT

Examiner

Timothy D Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 25-29 is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 10, 14, 16-18, 21 and 23 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 11-13, 15, 19, 20, 22 and 24 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5/7/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Requirement for Information Under 37 C.F.R. 1.105

1. Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

It appears from the record (petition to make special, filed 5/7/04) that there is at least one other individual producing and/or selling this device or similar. It also appears that the applicant knows some information about this competing device or there would not be a petition to make special for reasons of infringement. Therefore the examiner must require any information that the applicant has regarding this competing device.

Also it appears from the website <http://www.kavanaghballoons.com.au/> that there is a competing company "Cameron Balloons" which may also have a competing device which is called "RDS" which according to the website states: "we believe that this is actually one of our rejected ideas from the early days of R&D on the Smart Vent" from www.kavanaghballoons.com.au/pr030424-1.html. This would also appear to be directly related to the patentability of this case because it appears that the current case may be either the "smart vent", "lite vent" or a similar invention which has slight modifications if any. Because of the above more information on the prior sale, prior use and prior patenting of these devices is needed. Also the schematics or drawings of the "smart vent" and "lite vent" are also needed as these appear to also be relevant to the

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patentability of this application, as well as any drawings of the competing product that is believed to be infringing and when it was made or put on sale.

Accordingly the above information is required under 37 CFR 1.105. A statement by the applicant that this information is unknown and/or not readily available, will be accepted as a complete response to this requirement.

In regard to the above requirement notice is taken of the January 3, 2005 decision of the United States Court of Appeals for the Federal Circuit in the case of Star Fruits S.N.C. v. United States.

Pertinent portions of the said decision are reproduced below.

Under 37 C.F.R. § 1.105 the Office can require information that does not directly support a rejection. An agency's interpretation of its own regulations is entitled to substantial deference and will be accepted unless it is plainly erroneous or inconsistent with the regulation. See *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wa.*, 334 F.3d 1264, 1266 (Fed. Cir. 2003). Here, the Office considered information concerning any sale or public distribution of the claimed invention and any information concerning Breeder's Rights applications or grants as within the authorized scope of a Requirement For Information under section 1.105.

This interpretation is not plainly erroneous or inconsistent with the regulation. Congress has delegated to the Office the rulemaking power to "establish regulations, not inconsistent with law, which—(A) shall govern the conduct of proceedings in the Office." 35 U.S.C. § 2(b)(2) (2000) (formerly at 35 U.S.C. § 6(a) (1988), see *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549-50 (Fed. Cir. 1996)); *Stevens v. Tamai*, 366 F.3d 1325, 1333 (Fed. Cir. 2004). Section 1.105 stems from an initiative entitled Changes to Implement the Patent Business Goals. Through notice and comment rulemaking the Office made explicit the inherent authority of Office employees to require information from an applicant. The goal is to "encourage" employees to use that power to "perform the best quality examination possible." 65 Fed. Reg. 54,604, at 54,633 (September 8, 2000) (to be codified at 37 C.F.R. pts. 1, 3, 5, 10); see also 64 Fed. Reg. 53,772 (proposed October 4, 1999); 63 Fed. Reg. 53,498 (proposed October 5, 1998). The final rule permits that "the examiner or other Office employee may require the submission . . . of such information as may be reasonably necessary to properly

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examine or treat the matter." 37 C.F.R. 1.105(a)(1) (emphasis added).

We think it clear that "such information as may be reasonably necessary to properly examine or treat the matter," 37 C.F.R. 1.105(a)(1), contemplates information relevant to examination either procedurally or substantively. It includes a zone of information beyond that defined by section 1.56 as material to patentability, and beyond that which is directly useful to support a rejection or conclusively decide the issue of patentability. Several observations militate in favor of this conclusion.

First, under the current regulations an applicant has an affirmative duty to disclose information material to patentability. See 37 C.F.R. § 1.56. Because an applicant already has a duty to disclose this information, it makes no sense for the Office to promulgate a rule empowering it to "require the submission" of information the applicant is required to submit in the first instance.

Second, section 1.105 identifies the required information as that information "reasonably necessary to properly examine or treat the matter" instead of that information "material to patentability." Under ordinary principles of interpretation, the choice of different language indicates a different intended meaning.

Third, the plain language of the regulation contemplates requirements for information that go beyond information required by section 1.56. For example, "any non-patent literature . . . by any of the inventors, that relates to the claimed invention[.]" 37 C.F.R. § 1.105(a)(1)(iii) (emphasis added), could include sales brochures, catalogues, or PBR applications or grants. "[A]ny use of the claimed invention known to any of the inventors at the time the application was filed notwithstanding the date of the use," *id.* § 1.105(a)(1)(vii) (emphasis added), could refer to uses that would not affect patentability at all. Likewise, information directed to whether a search was conducted and what was searched, *id.* § 1.105(a)(1)(ii), is not necessarily required by section 1.56. Other requirements for information are also foreseeable under the "reasonably necessary to properly examine or treat the matter" standard. For instance, it might be reasonably necessary for the Office to require an explanation of technical material in a publication, such as one of the inventor's publications, or require the applicant's comments on a recent Federal Circuit opinion and how that opinion affects examination. See, e.g., 65 Fed. Reg. at 54,634. Although this information improves the quality and efficiency of examination it is not necessarily information that an applicant is required to provide under section 1.56. In sum, we think that the Office's interpretation of 37 C.F.R. § 1.105 conforms to the plain language of the regulation.....

The Director is charged with the duty of deciding whether a patent should issue from an application. To perform that duty, the law must be applied to the facts at hand in any application. That the person charged with enforcement of the law, here an examiner, may sometimes disagree with the applicant on the theory or scope of the law to be applied is hardly surprising. So long as the request from the examiner for information is not arbitrary or capricious, the applicant cannot impede the examiner's performance of his duty by refusing to comply with an information requirement which

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proceeds from the examiner's view of the scope of the law to be applied to the application at hand. To allow such interference would have the effect of forcing the Office to make patentability determinations on insufficient facts and information. Such conduct inefficiently shifts the burden of obtaining information that the applicant is in the best position to most cheaply provide onto the shoulders of the Office and risks the systemic inefficiencies that attend the issue of invalid patents. Examination under such circumstances is neither fair and equitable to the public nor efficient.

2. This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete reply to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action.

Information Disclosure Statement

3. The information disclosure statement filed 5/7/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

a. Note: The foreign citations were not considered because they only include English abstracts, the whole document is needed.

b. Also note that the US Patents that have been crossed out appear to be somehow mixed up. The names do not correspond with the numbers listed and the subject matter does not seem to match.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6,9,10,14,16-18,21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 01/26963 to Kavanagh (hereinafter called 963).

a. Re claim 1, 963 discloses a thermal aircraft (1) with outer envelope (2) containing hot air (see abstract) and supporting a load carrying basket (see claims at least), the envelope having an aperture (3), with spider (ring 4 and tapes as seen at least in page 9 at lines 2-6 under the "best mode" section of the specification). 963 also discloses removable venting means (5 also called a parachute panel) and first control means to move the periphery of the panel away from the aperture during flight (18,20, and 8 all act to move the panel this way), and second control means to draw the parachute panel inwardly and downwardly from the aperture for rapid deflation (see numbers 13,7, and 17 which move the panel in this way). Also 963 discloses a plurality of limiting lines attached at one end to the panel and at the other end to the load tapes. This is seen in that the limiting lines are numbered as 15 and they are attached to the panel on one end and to the ring (which attaches them to the load tapes of the spider configuration). Note the lines may not be directly attached to the load tapes but

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they are attached to the load tapes at their one end at least through ring 4. Also these limiting lines are "for limiting the downward movement of the parachute panel" because they will limit the movement of the panel away from the aperture if it were pulled down very far.

b. Re claim 2, 963 discloses that the limiting lines are attached at their said one ends to the parachute panel at or near its periphery as seen in the figure in that the periphery is near the line attachment. Also note that the terms "near" and "periphery" are relative and there is no frame of reference to base these off of, therefore the art meets the claim limitations which are broad because of the language.

c. Re claim 3, 963 discloses both modes of operation in that the first mode of operation is when the cord 8 is pulled and pulls the outer edges of the panel away from the edges of the aperture. The second mode of operation is when the cord is released and the panel goes back to seat with the envelope and cover the aperture.

d. Re claim 4, see rejection of claim 1 above.

e. Re claim 5, see rejection of claims 1 and 2 above.

f. Re claim 6, 963 discloses that the limiting lines lengths are substantially less than the radius of the panel, as seen in the figure. This is seen in that the terms "substantially less" have not been clearly defined and are relative. Also it can be seen in the figure that the lines length is less than the radius because the lines 15 end at about the edge of the aperture and the panel extends well under

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the aperture. It is suggested that the applicant use clearly and positively claimed terms that are well defined.

g. Re claim 9, 963 discloses both modes of operation in that the first mode of operation is when the cord 8 is pulled and pulls the outer edges of the panel away from the edges of the aperture. The second mode of operation is when the cord is released and the panel goes back to seat with the envelope and cover the aperture.

h. Re claim 10, 963 discloses that the limiting lines lengths are substantially less than the radius of the panel, as seen in the figure. This is seen in that the terms "substantially less" have not been clearly defined and are relative. Also it can be seen in the figure that the lines length is less than the radius because the lines 15 end at about the edge of the aperture and the panel extends well under the aperture. It is suggested that the applicant use clearly and positively claimed terms that are well defined.

i. Re claim 14, 963 discloses that the limiting lines are attached at their said one ends to the panel at positions spaced from the periphery of the panel as seen in the figure in that the lines 15 are seen in toward the center of the panel from its outer edge. The term "spaced" is relative and is taken as meaning not exactly on top of the edge of the panel.

j. Re claim 16, 963 discloses venting means for a thermal aircraft, the venting means being the parachute panel of 963. 963 discloses a thermal aircraft (1) with outer envelope (2) containing hot air (see abstract) and

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supporting a load carrying basket (see claims at least), the envelope having an aperture (3), with spider (ring 4 and tapes as seen at least in page 9 at lines 2-6 under the "best mode" section of the specification). 963 also discloses removable venting means (5 also called a parachute panel) and first control means to move the periphery of the panel away from the aperture during flight (18,20, and 8 all act to move the panel this way), and second control means to draw the parachute panel inwardly and downwardly from the aperture for rapid deflation (see numbers 13,7, and 17 which move the panel in this way). Also 963 discloses a plurality of limiting lines attached at one end to the panel and at the other end to the load tapes. This is seen in that the limiting lines are numbered as 15 and they are attached to the panel on one end and to the ring (which attaches them to the load tapes of the spider configuration). Note the lines may not be directly attached to the load tapes but they are attached to the load tapes at their one end at least through ring 4. Also these limiting lines are "for limiting the downward movement of the parachute panel" because they will limit the movement of the panel away from the aperture if it were pulled down very far.

k. Re claim 17, 963 discloses both modes of operation in that the first mode of operation is when the cord 8 is pulled and pulls the outer edges of the panel away from the edges of the aperture. The second mode of operation is when the cord is released and the panel goes back to seat with the envelope and cover the aperture.

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l. Re claim 18, 963 discloses that the limiting lines lengths are substantially less than the radius of the panel, as seen in the figure. This is seen in that the terms "substantially less" have not been clearly defined and are relative. Also it can be seen in the figure that the lines length is less than the radius because the lines 15 end at about the edge of the aperture and the panel extends well under the aperture. It is suggested that the applicant use clearly and positively claimed terms which are well defined.

m. Re claim 21, it can be seen from 963 that the limiting lines are attached near the periphery in that they are closer to the periphery than the center of the panel as seen in the figure. Note: "near" is a relative term, it is suggested that the applicant use clearly and positively claimed terms that are well defined.

n. Re claim 23, 963 discloses that the limiting lines are attached at their said one ends to the panel at positions spaced from the periphery of the panel as seen in the figure in that the lines 15 are seen in toward the center of the panel from its outer edge. The term "spaced" is relative and is taken as meaning not exactly on top of the edge of the panel.

Allowable Subject Matter

NOTE: The following "allowable subject matter" is set forth with the understanding that any information that is revealed through the "Requirement for Information Under 37 C.F.R. 1.105" may lead to the rejection of the claims stated in this section.

6. Claims 7,8,11-13,15,19,20,22, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 25-29 are allowed.

8. The following is a statement of reasons for the indication of allowable subject matter: the prior art of record all failed to show either alone and or in combination a balloon with parachute panel that has limiting lines that are slidably attached to the load tapes. Also the prior art did not show attaching two of the limiting lines to parachute panel at the same position. Also the prior art did not show attaching the limiting lines to the first attachment points on the inner surface of the envelope at their one end and the other end at or near the edge of the parachute panel with the lines extending across the aperture when the panel closes the aperture.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following disclose balloons.

- o. www.kavanaghballoons.com.au/pr030424-1.html

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- p. www.cameronballoons.co.uk/news/pr/arch/04apr03.html
- q. www.kavanaghballoons.com.au/pr030227-1.html
- r. www.kavanaghballoons.com.au/pr12012001.html
- s. www.kavanaghballoons.com.au/sv.html
- t. www.kavanaghballoons.com.au/pr030408-1.html
- u. US 2004/0238692 A1


10. This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete reply to the attached requirement for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy D Collins whose telephone number is 571-272-6886. The examiner can normally be reached on M-F, 7:00-3:00, with every other Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M Poon can be reached on 571-272-6891. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Timothy D. Collins
Patent Examiner
Art Unit 3643


PETER M. POON
SUPERVISORY PATENT EXAMINER
5/31/05